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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,154	07/16/2003	James L. Sumiejski	3218R	1207

26645 7590 12/11/2006

THE LUBRIZOL CORPORATION  
ATTN: DOCKET CLERK, PATENT DEPT.  
29400 LAKELAND BLVD.  
WICKLIFFE, OH 44092

EXAMINER

RONESI, VICKEY M

ART UNIT PAPER NUMBER

1714

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/621,154

Applicant(s)

SUMIEJSKI ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-22 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-22 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/2006 has been entered.
2. All outstanding objections and rejections are withdrawn in light of applicant's amendment filed 9/28/2006.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. Claims 1, 2, 4-22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (WO 00/70001).

Ward discloses a lubricating composition for use in transmissions (abstract, page 3, lines 19-31) preparing by mixing the following ingredients (page 22, lines 23-25): 0.05-5 wt % (page 18, lines 7-8) phosphorus anti-wear additive including preferably a phosphite ester having alkyl groups with at least 8 carbons atoms (page 15, lines 26-29) or mixtures of alkyl groups with C<sub>18</sub>, C<sub>20</sub>, C<sub>22</sub>, and C<sub>24</sub> (page 16, lines 30-34); 0.1-0.45 wt % (page 20, lines 22-24) one or more

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friction modifiers including isostearic acid condensation products of polyamines such as tetraethylene pentamine and diaminomethane including those containing amide and imidazoline functional groups (page 18, lines 20-23; page 19, lines 8-31) and borated epoxides prepared by reacting hydrocarbyl epoxide with boric acid or boron trioxide (page 19, line 32 to page 20, line 21; page 23, table); 0.1-5 wt % (page 9, lines 15-17) borated dispersant from the reaction of polyisobutylene-substituted succinic anhydride with polyethyleneamines (page 9, lines 19-36; page 23, lines 10-12); and at least 80 wt % (page 4, lines 10-15) oil of lubricating viscosity of API Groups II or III (page 4, lines 10-26) or Group (IV (page 4, line 37); and other additives (page 20, lines 31-37). A concentrate can be prepared comprising 10-50 parts by weight lubricating oil )page 21, lines 11-30).

While Ward does not exemplify a lubricant composition comprising each and every one of the presently claimed ingredients, this does not negate a finding of obviousness under 35 USC 103 since a preferred embodiment such as an example is not controlling. Rather, all disclosures “including unpreferred embodiments” must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972). Therefore, it would have been obvious to one of ordinary skill in the art to utilize a lubricant composition comprising a lubricating oil and the presently claimed additives given that Ward teaches each one.

5. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (WO 00/70001) in view of Farnig et al (US 5,006,270).

The discussion with respect to Ward in paragraph 4 above is incorporated here by reference.

Ward does not explicitly teach the use of an optional borate ester like presently claimed, however, it is open to the use of antioxidants (page 20, line 31).

Farnng et al discloses a lubricant composition and teaches that borate esters such as tributyl borate (col. 3, lines 53-65) have excellent multifunctional/antioxidant activity (col. 1, lines 16-19).

Given that Ward is open to antioxidants and further given that borate esters such as tributyl borate provide for excellent antioxidant properties in lubricant compositions as taught by Farnng et al, it would have been obvious to one of ordinary skill in the art to utilize tributyl borate in the composition of Ward to impart desired antioxidant properties.

#### ***Response to Arguments***

6. Applicant's arguments filed 9/28/2006 have been fully considered but they are not persuasive. Specifically, applicant argues that the data in the 1.132 declaration filed 5/1/2006 serves to establish unexpected and surprising results for an alkyl phosphite with an alkyl group containing 12-30 (or 14-20) carbon atoms in a lubricating composition when compared to a lubricating composition containing an alkyl phosphite with an alkyl group containing 6 carbon atoms.

In response to the argument, the examiner agrees that the data establishes expected and surprising results for an alkyl phosphite with an alkyl group containing 14-20 carbon atoms compares to an alkyl phosphite with 6 carbon atoms, however, it is noted that new grounds of rejection over Ward (WO 00/70001) are set forth above wherein Ward discloses an alkyl phosphite with at least 8 carbon atoms (page 15, lines 26-29) or mixtures of alkyl groups with

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C<sub>18</sub>, C<sub>20</sub>, C<sub>22</sub>, and C<sub>24</sub> (page 16, lines 30-34). Given that Ward does not teach an alkyl phosphite with 6 carbon atoms in the alkyl group, the data in the declaration has no probative value with respect to newly cited Ward.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/30/2006  
Vickey Ronesi

*VR*

*Vasu Jagannathan*  
VASU JAGANNATHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700